

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/767,722

REMARKS

The Examiner's statutory rejections appear to be substantially to the same as those appearing in the previous Office Action, with at least the following notable exceptions:

1. Independent claim 6 is now included with independent claim 7 in the rejection of claims 2-7 (and new claims 9-16) under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Kalbermatter '978 in view of Hatuse '115 (on page 5 of the previous Office Action, the Examiner had stated that claim 6 "would be **allowable** if rewritten in independent form"); and
2. In an effort further to buttress the rejection of independent claim 7, the Examiner now relies on "**Official Notice**" as reflected in the following statement:

Kalbermatter modified by Hatuse fails to teach that [sic] the keyboard being **deposited** in **only** the crystal watch thinned zone. However, the Examiner takes "official notice" that a keyboard being **deposited** in **only** the crystal watch thinned zone is well known [?] in the art.

The Examiner then makes the conclusory statement:

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Hatuse with Kalbermatter, in order to reduce the dimension of telephone to the point that it can be carried on the human body and at the same time avoiding pressing several keys at the same time.

Applicant **incorporates** herein by reference Applicant's just previous (still valid) rebuttal arguments to the rejections on the Kalbermatter/Hatuse combination based on statutory obviousness.

In the rejection of claim 6, the Examiner **again admits that** Kalbermatter **fails**

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to teach the watch including: a keyboard disposed under a lower face of the surface, said crystal including a thick zone and a thinned zone, the keyboard being deposited in the thinned zone, the entire surface of telephone watch is crystal, and the keyboard formed in particular of a plurality of capacitive sensors, the keys being activated by placing a finger on the upper face of the crystal opposite that at least one electrode, wherein the crystal includes a thick zone and a thinned zone, the keys of the keyboard being arranged in the thinned zone; and wherein it is secured into a bezel including an inner reinforcement extending under the thinned zone of the crystal, the keyboard being sandwiched between the thinned zone and the reinforcement.

The Examiner makes a similar statement in support of the rejection of claim 7:

Kalbermatter **fails to teach** a keyboard disposed under a lower face of the surface, said crystal including a thick zone and a thinned zone the keyboard being **deposited** in **only** the thinned zone, the entire surface of telephone watch is crystal, and the keyboard formed in particular of a plurality of capacitive sensors, the keys being activated by placing a finger on the upper face of the crystal opposite the at least one electrode.

Applicant must now turn to the Examiner's use of "official notice" to dismiss a critical limitation of claim 7 (and claim 6).

Applicant refers the Examiner to MPEP §2144.03, paragraphs A, B and C, and **traverses the Examiner's finding of "official notice"** and in particular, the Examiner's assertion that "a keyboard being **deposited** in **only** the crystal watch thinned zone is well known in the art".

As stated in paragraph A,

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

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This "official notice" replaces the Examiner's (now withdrawn) previous statement that "Hatuse teaches a crystal telephone wristwatch wherein the keys and the keyboard are arranged **only** in the thinned zone".

Applicant's previous analysis of Kalbermatter's disclosure is specifically incorporated herein by reference.

Applicant's previous analysis and rebuttal arguments regarding Hatuse are also incorporate herein by reference.

Hatuse '115, in fact, teaches a keyboard disposed under a lower surface of a crystal of a watch, wherein the crystal comprises a central portion of constant thickness and a beveled peripheral portion. The beveled peripheral portion, considered as the thinned portion by the Examiner, has a variable thickness which decreases towards the outside. Moreover, the surface of each of the keys (45, 69) of the keyboard shown in Hatuse spreads over both the central thick portion and also the beveled portion of the crystal. Such a structure does not offer a reliable control especially with a crystal having a thickness sufficiently thick to be water resistant, as the capacitance will vary depending on the location where the user places his finger, i.e., on the central portion, on the beveled portion, or even between the central and the beveled portions of the crystal.

Since Hatuse **teaches away** from the subject matter defined in Applicant's independent claim 7, Applicant respectfully submits that the Examiner has not made a showing of *prima facie* obviousness of the subject matter of independent claim 7 and its dependent claims. Furthermore, even if the teachings of Kalbermatter and Hatuse were combined, there would not be produced a

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crystal containing all of the limitations/features of claim 7 and its dependent claims 2-5, 9 and 10.

Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 103(a), and to **allow** the pending claims 2-7 and 9-14 and 16.

In an effort to obtain an allowance of the application and further patentably to define Applicant's claimed invention relative to the Kalbermatter/Hatuse combination, Applicant has added to independent claims 7 and 6 the limitation: "wherein the upper face of the crystal has a continuous smooth curved surface". As a result of this geometrical configuration, the thickness reduction is "transparent" to the wearer as being made on the interior face of the watch crystal, thereby improving the aesthetics of a watch equipped with this crystal. Such a "continuous smooth curved surface" on the exterior face of the crystal is **not** disclosed or even suggested by Hatuse (or Kalbermatter).

Furthermore, Hatuse teaches a keyboard disposed under a lower surface of a crystal of a watch wherein the crystal comprises a central portion of constant thickness and a beveled peripheral portion. The **exterior** surface of the crystal is therefore not a continuous smooth curved surface. Moreover, referring to Hatuse's Figures 3 and 4, one can clearly distinguish the flat portion from the beveled portion, and can see that the keys of the keyboard are arranged over the central **thick** portion. The beveled peripheral portion, considered as the "thinned portion" by the Examiner, is covered only by conductive paths connecting the key electrode to the conductive connectors placed underneath the thinned portion, said conductive connector not acting as a "reinforcement" member.

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Since the Kalbermatter/Hatuse combination does not disclose, or even suggest, all of the limitations of claims 2-7, 9-14 and 16 (claim 15 has been canceled as being redundant), Applicant respectfully submits that Kalbermatter/Hatuse is **incapable of rendering prima facie** obvious **the subject matter of each of these claims**, whereby Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 103(a) and to find the application to be in condition for allowance with claims 2-7, 9-14 and 16.

REQUEST FOR INTERVIEW

This is the **fifth** Office Action in this case, and Applicant sincerely believes that the pending claims define patentable subject matter and, thus, would like to avoid an appeal. The Examiner's reliance on "official notice" appears to be not well placed, and if the Examiner persists in finding of "official notice", Applicant respectfully traverses the involved rejection, and, MPEP §2144.03, expressly requests the Examiner to cite a reference showing the feature of which the Examiner takes "official notice".

Thus, if the application is not now in condition for allowance, Applicant respectfully requests Examiner Mehrpour to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application, in particular, any additional claim amendments which the Examiner may feel are required in order, in her opinion, to patentably distinguish the claimed subject matter from the Kalbermatter/Hatuse combination within the meaning of 35 U.S.C. § 103(a).

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to

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Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,

/John H. Mion/
John H. Mion
Registration No. 18,879

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
(202) 663-7901

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